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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/447,419      | 11/23/1999  | HARUO TANAKA         | 040894-5507         | 3789             |

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MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER

SANTIAGO, MARICELI

ART UNIT PAPER NUMBER

2879

DATE MAILED: 09/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/447,419

Applicant(s)

TANAKA, HARUO

Examiner

Mariceli Santiago

Art Unit

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 29, 2002 has been entered.

### ***Response to Amendment***

The Amendment, filed on February 28, 2002, has been entered and acknowledged by the Examiner.

Cancellation of claim 4 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glaser (US 4,303,847) in view of Ohnuma et al. (US 5,118,986).

Regarding claim 1, Glaser discloses a flat panel display comprising a sealing member for sealing the flat panel display structure and covering the panel with the sealing member, wherein the sealing member is further comprised of an aluminum material (85, Column 4, lines 30-38) and an absorbing material (84), which is made of a porous aluminum oxide layer on an inner surface thereof (Column 7, lines 9-22). Glaser discloses the general use of the sealing member in various types of flat panel displays including EL panels (Column 1, lines 8-12). In the same field of endeavor, Ohnuma discloses a common EL device structure comprising a lower electrode (2) formed on a substrate, an organic EL layer formed on the lower electrode (5, 6), and an upper electrode (3) formed on the organic EL layer. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the organic EL panel disclosed by Ohnuma as the flat panel of Glaser since an EL device is a well know flat panel structure and Glaser discloses the general suitability of the sealing member for flat panel displays.

The Examiner notes that the claimed limitation "formed by anodic oxidation of the aluminum material" is drawn to a process of manufacturing which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. In spite of the fact that a product-by-process claim may recite only process limitations, it is the product and not the recited process that is covered by the claim. Further, patentability of a claim to a product does not rest merely on the difference in the method by which the product is made, rather, it

is the product itself which must be new and not obvious. As such, no patentable weight has been given to the process recited in claim 1 (see MPEP 2113).

The recitation "for absorbing an impurity" is considered an intended used recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). Accordingly, it is the position of the Examiner that the claimed recitation is inherently taught as evidenced by Glaser's suggestion of all of the Applicant's claimed structural limitations.

Regarding claim 2, Glaser discloses a flat panel display (see Fig. 2) wherein the aluminum material (Column 4, lines 33-38) is a flexible aluminum sheet (18).

Regarding claim 5, the Examiner notes that the claimed limitation "the aluminum sheet is formed in such a manner that a surface of the aluminum oxide layer is subjected to gas flow-out treatment in vacuum, and thereafter the lower electrode, EL layer and upper electrode are sealed on the substrate in an atmosphere of inert gas" is drawn to a process of manufacturing which is incidental to the claimed apparatus. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. In spite of the fact that a product-by-process claim may recite only process limitations, it is the product and not the recited process that is covered by the claim. Further, patentability of a claim to a product does not rest merely on the difference in the method by which the product is made, rather, it is the product itself which must be new and not obvious. As such, no patentable weight has been given to

the process recited in claim 1 (see MPEP 2113). Furthermore, Glaser discloses all the elements of the flat panel display being sealed on the substrate in an atmosphere of inert gas (Column 2, lines 39-63).

### ***Response to Arguments***

In response to Applicant's arguments, the arguments are based on a rejection based on U.S. Patent No. 4,427,479 to Glaser et al. in view of U.S. Patent No. 5,118,986 to Ohnuma et al. However, the Examiner notes that the rejection stated in the final Office Action, Paper No. 7, was based in U.S. Patent No. 4,303,847 to Glaser in view of U.S. Patent No. 5,118,986 to Ohnuma et al. Accordingly, Applicant's arguments are considered non-responsive to the rejection stated in the final Office Action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariceli Santiago whose telephone number is (703) 305-1083. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (703) 305-4794. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382. Additionally, the following fax phone numbers can be used during the prosecution of this


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application (703) 872-9318 (for response before a Final Action) and (703) 872-9319 (for response after a Final Action).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

*Msgr 8/28/02*  
Mariceli Santiago  
Patent Examiner  
Art Unit 2879

  
ASHOK PATEL  
PRIMARY EXAMINER